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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/291,294 04/14/99 PALTENGHE

C CITI0131-US

EXAMINER

TM02/0905

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NORMAN, M

ART UNIT

PAPER NUMBER

2163

DATE MAILED:

09/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/291,294

Applicant(s)

PALTENGHE ET AL.

Examiner

Marc E. Norman

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-12,14-32,34,38-41,44-56,58-62,64-67 and 69-92 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-12,14-32,34,38-41,44-56,58-62,64-67 and 69-92 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 26 July 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Office Action presents a new rejection of subject matter that was previously indicated as being allowable. Based on a discussion with his Supervisor, the Examiner has concluded that further issues need to be addressed. Since the new grounds of rejection were not necessitated by Applicant's Amendment, this Office Action is made Non-Final. Examiner apologizes for any inconvenience caused by this second rejection.

Specifically, the issue at hand is whether the limitation regarding a virtual executor function of an virtual wallet application is patently significant. This limitation may be dissected into two parts: first, whether there is anything inherently significant about a virtual executor function; and second, whether there is any significance to applying this function within a virtual wallet application.

Regarding the first issue, Applicant defines this function as one that "automatically escrows a trusted third party's access aspect of the owner's secret device for accessing the stored data. Upon verification of the occurrence of the event, the virtual executor provides access to the stored data using the trusted third party's access aspect." (see Abstract) However, those basic steps were rejected as being unpatentable in the original Office Action (see, for example, the rejection of original claim 1). Accordingly, the term "virtual executor function" is actually simply a label for these unpatentable steps and is thus not itself a patently significant limitation.

Regarding the second issue, Examiner notes that an "electronic wallet application" is simply one of many potential applications to which the basic invention might be applied. In fact, automatic escrowing may be applied to any electronic secret (see, for example, the Fischer

Art Unit: 2163

reference). Furthermore, "electronic wallet application" is a broad term and, for the purposes of patentability, does not clearly define the metes and bounds of the invention. Accordingly, this aspect of the limitation is also given little patentable weight.

Finally, it is also noted that, as the claim language is written (see, for example, claim 1), the virtual executor function is actually non-functional data. The claim language simply states "the virtual wallet application having a virtual executor function...." There is nothing in the claim language that indicates that the steps that follow are carried out by the virtual executor. As non-functional data, this limitation would also not be patently significant.

Once again, Examiner apologizes that these issues were not raised in the initial Office Action. However, Examiner hopes that the present analysis serves to clarify patent prosecution.

### ***Claim Rejections - 35 USC § 103***

Claims 1, 3-12, 14-32, 34, 38-41, 44-56, 58-62, 64-67, and 69-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer in view of Rosen.

These claims are fundamentally unchanged from the original Office Action except that original independent claims 1 and 81 has incorporated the limitation regarding a virtual executor function of an virtual wallet application; and 32, 41, 56, 62, and 67 have been placed in independent form by incorporating the language of claim 1, including the limitation regarding a virtual executor function of an virtual wallet application. Accordingly, the original rejections of these claims are carried forward and maintained in further view of the discussion above regarding the limitation "a virtual executor function of an virtual wallet application" not being patently significant.

### *Drawings*

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 7/26/01 have been approved. In view of revised PTO procedure, corrected drawings are required to reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Green et al. teaches a system for digitally signed contracts wherein an executor is specified.

Paltenghe et al. teaches a virtual wallet system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc E. Norman whose telephone number is 703-305-2711. The examiner can normally be reached on Mon.-Fri., 8:00-5:30, with first Fridays off.

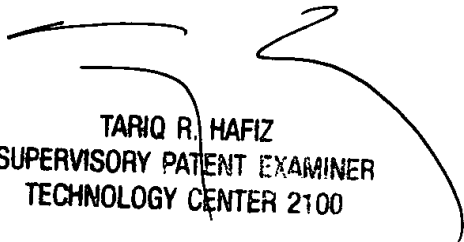
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Application/Control Number: 09/291,294  
Art Unit: 2163

Page 5

MN  
August 30, 2001



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